

REMARKS

1. The Amendments, the Support Therefor, and Basis for Entry

One claim (32) has been canceled, six new claims (37-42) have been added, and claims 21, 23, 29, and 34 have been amended to leave claims 21-25, 27-31, and 33-42 in the application. No new matter has been added by the amendments or new claims, wherein:

- **CLAIM 21:** Amended to incorporate features of claim 32 (now canceled) and FIGS. 4-8.
- **CLAIM 23:** Finds support at, e.g., FIGS. 4-5 (showing insertion element 30 and delivery conduit 31).
- **CLAIM 29:** Finds support at, e.g., FIG. 1 and page 15 lines 17-23.
- **CLAIM 34:** Finds support at, e.g., FIG. 1 and page 15 lines 17-23.
- **New CLAIM 37:** Corresponds to claims 23-24, with additional features from claim 27 (and claim 1) incorporated.
- **New CLAIM 38:** Corresponds to claim 25.
- **New CLAIMS 39-42:** Correspond to claims 38-41.

2. Information Disclosure Statement (Form PTO-1449)

Please note that this Response is accompanied by an Information Disclosure Statement (IDS) citing references recently cited by a foreign patent office in a counterpart foreign application. As per §1.97(b)(4), no fee should be due for this IDS.

3. Section 2 of the Office Action: Objections to the Drawings

Kindly reconsider and withdraw the objection to the drawings, which appear to refer to the matter of claims 31 and 36. (The claims reciting the allegedly unshown matter are not identified.) If it is in fact the matter of claims 31 and 36 which is in issue, please note that the claimed features are shown in FIGS. 1 and 4-8, which show the balloon catheter 6 lashed to the delivery tube 5 in such a manner that they are pivotally fixed together. Note, for example, page 17 lines 4-7 of the application. If the objection should be maintained, kindly identify the claims that are believed to lack illustration.

4. Sections 3-4 of the Office Action: Rejection of Claims 28 and 33 under 35 USC §112(1)

Kindly reconsider and withdraw these rejections. The guide wire finds support at (for example) originally-submitted claim 3.

5. Sections 5-6 of the Office Action: Rejection of Claims 29-30, 34-35 under 35 USC §112(2)

Kindly reconsider and withdraw these rejections, which are believed to be addressed by the clarifying amendments to claim 29 (from which claim 30 depends) and 34 (from which claim 35 depends).

6. Sections 7-8 of the Office Action: Rejection of Claims 21-25 under 35 USC §102 in view of U.S. Publ'n. 2003/0176766 to Long et al.

The rejection of *CLAIM 21* (and its dependent claim 22) is addressed by the amendment to claim 21 to incorporate features of claim 32 (which was not subject to rejection in view of *Long et al.*), as well as features shown in FIGS. 4-8. Claim 21 therefore now recites that the insertion element has an outer circumference extending alongside and exterior to an outer circumference of the delivery conduit at the pivotal coupling, and for lengths extending proximally and distally therefrom. *Long et al.*'s insertion element 14 clearly does not have an outer circumference extending alongside and exterior to an outer circumference of the delivery conduit for a length extending distally from the pivotal coupling, and thus claim 21 (and its dependent claim 22) are not anticipated by *Long et al.*. These claims are also not obvious in view of *Long et al.*, since *Long et al.* cannot be modified to meet the recitations of claim 21 and still remain operational, since the *Long et al.* delivery conduit must extend distally of the insertion element. See MPEP 2143.01 (subsection entitled "The Proposed Modification Cannot Render The Prior Art Unsatisfactory For Its Intended Purpose").

The rejection of *CLAIM 23* (and also its dependent claims 24 and 25) is similarly addressed by the amendment to claim 23 to specify that the distal end of the elongated insertion element extends *longitudinally* beyond the distal end of the distal end of the delivery conduit. Claim 23 is therefore novel and unobvious in view of *Long et al.* for reasons similar to those noted above with respect to claim 21.

7. Sections 9-11 of the Office Action: Rejection of Claims 21, 23, and 27-36 under 35 USC §103(a) in view of U.S. Patent 6,416,522 to Strecker

Strecker shows a balloon catheter 141 which slides along a guide wire 142 for insertion into a body, and which has a passage 27 therein for delivery of staples:

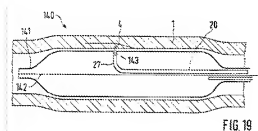


FIG. 19 finally shows an implantation device 140, in which the pretension required for body vessel 1 is produced by means of a balloon catheter 141. Balloon catheter 141 is placed in body vessel 1 with the help of a guide wire 142 and then expanded as intended. Hollow body 27 of implantation catheter 30 partly extends through balloon catheter 141 and

feeds into a predetermined opening 143 in the outer shell of balloon catheter 141, from which also securing means 4 is implanted in the vascular wall of body vessel 1 in the manner described in the foregoing.

Both of **CLAIMS 21 and 23** recite that the insertion element is stiffer than at least the distal end of the delivery conduit, a condition which is not present in *Strecker*, and which no ordinary artisan would incorporate into *Strecker*. The alleged insertion element 141 of *Strecker* is an inflatable balloon; it must necessarily be highly flexible. At the same time, the alleged delivery conduit 20 of *Strecker* – referred to as “implantation catheter 30” in the *Strecker* text (see column 12 line 66-column 13 line 4) – is intended to transmit and eject “securing means 4,” i.e., fasteners. The *Strecker* delivery conduit must necessarily be somewhat rigid to allow such fasteners to smoothly travel along its interior without catching in the delivery conduit, or without attempting to continue traveling along a straight line rather than along the curve of the delivery conduit. No ordinary artisan would seriously consider making the delivery conduit 20 of flexible material suitable for use as an inflatable balloon: such material is simply unsuitable to convey fasteners, particularly fasteners with sharp tips. Claims 21 and 23, and thus their dependent claims, are therefore unobvious.

Additionally, **CLAIM 21** recites that the outer circumference of the delivery conduit extends alongside and exterior to the outer circumference of the insertion element at the pivotal coupling between these elements. In *Strecker*, the alleged delivery conduit 20 does not have an outer circumference extending alongside and exterior to the outer circumference of the alleged insertion element 141; rather, the delivery conduit 20 extends within the alleged insertion element 141. Further, there is no apparent reason why an ordinary artisan would contemplate modifying *Strecker*

to meet the recitations of claim 21, and it also seems unlikely that *Strecker* could be modified to meet the recitations of claim 21 and still result in a device which operates as desired.

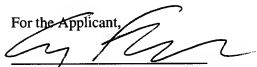
8. New Claims 37-42

New independent **CLAIM 37** corresponds to claim 23 with claims 24 and 27 incorporated (with the incorporated features of claim 27 being similar to those now amended into claim 21). Claim 37 is submitted to be novel and unobvious in view of *Long* for the same reasons as claim 21 (discussed previously). Further, claim 37 should be allowable over *Strecker* because it incorporates features of claim 24, which was not rejected in view of *Strecker*. New **CLAIMS 38-42**, dependent from claim 37, are submitted to be novel and unobvious for at least the same reasons as claim 37.

9. In Closing

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,



Craig A. Fieschko, Reg. No. 39,668
CUSTOMER NO. 25005
DEWITT ROSS & STEVENS S.C.
2 E. Mifflin St., Suite 600
Madison, WI 53703-2865
Telephone: (608) 395-6722
Facsimile: (608) 252-9243
cf@dewittross.com